

REMARKS

Applicant respectfully traverses and submits the Restriction/Election is improper as the Examiner has not met the initial burden for supporting the inventions as being distinct from each other.

The Examiner asserts that these inventions are distinct because the device of Group I could be made by a process materially different from those of Group II, such as the process of claim 17 being carried out simultaneously. Applicant respectfully disagrees and submits that the Examiner has misinterpreted and misapplied the proper interpretation of claim 17, in accordance with MPEP §2111 and further in support of In re Cortright, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999). Claim 17 recites, among other things, a method for making an integrated circuit comprising coupling a system memory to a top surface and coupling a northbridge to a bottom surface of a carrier substrate. In the Examiner-cited example of a “materially different” process for making the invention of Group I, the Examiner has herein improperly asserted the limitation of the method steps of claim 17 being done in a first and then next order. Under the plain interpretation of the claim language, in accordance with MPEP § 2111.01, it is asserted that claim 17 would in-fact as currently presented, encompass the Examiner-cited materially different process for making the invention of Group I. In other words, there is no specific limitation in claim 17 that prohibits claim 17 from expressly encompassing the Examiner’s example in the stated motivation for the present Restriction/Election, in accordance with MPEP § 806.05(f).

Therefore, Applicant respectfully resubmits that the present Restriction/Election is improper as these inventions are not subject to a Restriction/Election, but may be examined under the same application. Moreover, Applicant respectfully submits that the Examiner has not met the requisite burden of proof for supporting the present Restriction/Election, in accordance with MPEP § 806.05(f). Furthermore, in accordance with MPEP § 806.05(f), it is submitted that the burden should shift to the Examiner to document a viable alternative process or product, or withdraw the Restriction/Election requirement. Therefore, Applicant respectfully requests withdrawal of the present Restriction/Election, or should the Examiner maintain the present

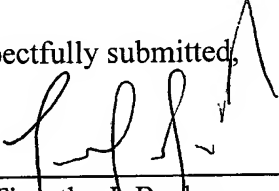
Restriction/Election, Applicant requests a showing in support of the Examiner's requisite support for the present Restriction/Election, in accordance with MPEP § 806.05(f).

Assuming *arguendo*, Applicant maintains the traverse of the present Restriction/Election, but in order to be compliant with the present outstanding Office Action, Applicant provisionally elects Group I, claims 1-16.

As such, Applicant respectfully traverses the Examiner's asserted Restriction/Election and respectfully submit herein that the Restriction/Election is improper and that all claims may be examined in the present application.

Accordingly, Applicant respectfully submits that the claims are in condition for allowance and that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below-listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Date: November 6, 2003

Respectfully submitted,

By: _____
Timothy J. Bechen
Registration No. 48,126

VEDDER, PRICE, KAUFMAN &
KAMMHOLZ, P.C.
222 North LaSalle Street
Chicago, IL 60601
Telephone: (312) 609-7870
Facsimile: (312) 609-5005